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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/929,836	09/15/1997	RUSSELL DONOVAN ARTERBURN	6971	2308

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EXAMINER

HOFFMANN, JOHN M

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.	Applicant(s)	
08/929,836	ARTERBURN, RUSSELL DONOVAN	
Examiner	Art Unit	
John Hoffmann	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11-13-04 has been entered.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is drafted in Jepson style. There is no indication as to what structure the improvement is an improvement of. Claim 1 starts out "In a bushing" it is not stated what is "in" the bushing beyond the improvement. See the Board Decision in the Parent application which indicates that a Jepson-style claim must identify what is improved (in addition to the improvement itself). It is unclear if the preamble is to be interpreted as "A bushing for making fibers..." or "Any structure that is IN a bushing..." or what. Line

5: it is unclear if "said sidewall" is to be interpreted as "said at least one sidewall" or something else. There is no antecedent basis for "the total area of the second screen", "the percentage of the hole area of said first screen" and "the total area of the first screen".

Claim 2 has very similar language as claim 1 and is indefinite for substantially the same reasons. Line 4: it is unclear what is mounted on an interior of the bushing and what is spaced above the top.

Claim 3: there is no antecedent basis for "the major portion". This makes it unclear as to whether the metal must have one component that is more than 50% or what.

The "portions" of claim 2 are indefinite as to their meaning. During the prosecution of this invention, Examiner interpreted the claims as follows: "Anyone can designate any section, sub-section, sub-subsection or sub-sub-sub-section near an end to be an 'end portion' simply because it is a 'portion' near an end. Applicant and the Board disagreed with this assessment. If a portion cannot be arbitrary, then it must be specific. Examiner is at a complete loss as to how to determine from the prior art as to whether a portion (that is at the end of a screen) is or is not an "end portion".

Since Examiner cannot determine the scope of "end portion", Examiner cannot ascertain whether the present "end portions" result in a novel and unobvious invention. Furthermore, one of ordinary skill would not be able to tell whether their portions that

occur at the end of a screen constitute an "end portion". The same problem applies to "central portion".

Claim 16: It is unclear what "that" (line 8) refers to. There is no indication that the holes have a diameter (they could be square holes), or there could be multiple sized holes. This language makes it unclear whether claim 16 requires that all of the holes of the screen must be of the singular "that" diameter. And unclear whether a screen which has a hole which lacks "that" diameter, result in an apparatus which does not read on the claim invention.

Also at line 10 of claim 16: there is confusing antecedent basis for "molten glass": it is unclear whether it is the same glass of line 3, or if it reads on the resistance of another hypothetical/arbitrary glass flow. Further, there is confusing antecedent basis for "flow" of lines 10 and 11.

Claim 11: the various "portions" are indefinite for the reasons given above.

Claim 21: the preamble calls for a method that is "in a multi-bushing fiberizing operation". Therefore the claim requires both the "method" and the "operation" but there is no indication what the operation is, or what it requires. This is essentially the same as the Board's determination: "It is impossible to determine from the specification and claims what steps are included in the recited "fiberizing operation"". Also, as the Board states: the meaning of "channel positions" is not readily apparent.

Claim 24 is incomplete. At a bare minimum, the claim must end with a period. The claim fails to state what the hole area "is". The last line of the claim is: "or central

portion of said second screen is" (no period) Applicant is reminded that the list of claims must be separate from all other portions of the amendment.

The above is not necessarily a complete list. The language of the claims have many similarities. If any second claim has language that is deemed indefinite in a first claim, it is also indefinite in the second - and any other claim that has that language.

**The burden is on Applicant to remove all** of the above mentioned limitations from **all** the claims that have the limitations - or otherwise demonstrate the limitations are not indefinite.

### ***Response to Arguments***

Applicant's arguments filed 12-23-03 have been fully considered but they are not persuasive.

It is argued that the specification identifies what is meant by "channel position". This is not convincing: the Board has already determined that the term is indefinite. There are various reasons why the term "channel position" makes the claims indefinite. For example, a position is not structure, it is merely a location. Any free space could be a channel position. Second, it is not a position of a channel, and it isn't even in a channel; it is beneath the channel. More importantly, the top of page 9 of the arguments, it is stated that the second position can also be a channel position. One of ordinary skill would be at a complete loss as to whether his/her second position is also a

channel position. Maybe a third, fourth or even 5<sup>th</sup> position can be a channel position - an artisan would be unable to tell. MOST importantly, Applicant has still refused to indicate what is meant by "channel position". There mere fact that the specification refers to the channel position is largely irrelevant as to whether the term is indefinite. What might be construed to be a definition "The first position in each of the legs, the positions next to the channel, are called channel positions", is not a definition, because second positions may also be channel positions.

As to the argument that US Pat 5935291 is not prior art, is not understood. Namely, the relevance of this argument is not understood. It is argued that the present "portions" are just as definite as the "regions" in the Patent. Clearly the terms of '291 are definite when interpreted in light of the '291 specification. The same is not true in the present application.

It is argued that the Board did not state that the end portion is of "arbitrary meaning". The relevance of this is not understood. The term indefinite because there is no meaning given to it. Applicant refuses to indicate what "end portion" means.

It noted that on page 11, Applicant describes what is meant by the end portion and "mid or center portion". Such are unacceptable. Applicant has already taken the position that the Stalego portions (as indicated in the Examiner's answer and the immediately prior Final Rejection) are not "end portions". Applicant's newly presented discussion on page 11, defines the portions in a manner which permit one to consider the Stalego portions to be "end portions". This contradicts the previously held position. The Board has already determined that the Stalego's end portions are not end portions -

therefore, Applicant's new description of "end portion" is inappropriate. Applicant cannot now define "end portions" in a way that contradicts the Board's determination.

Page 11 also ask various questions: The construction of claims is Applicant's burden. Examiner had previous held the position that Applicant now seems to hold. However, given the Board's decision, Examiner can no longer take that position (i.e. that any portion at an end is an "end portion"). Likewise, Examiner cannot allow the claims which would be interpreted based on that position.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1700.



John Hoffmann  
Primary Examiner  
Art Unit 1731

1-16-04

jmh